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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/660,186

09/11/2003

Ronald Scott Beckley

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EXAMINER

BERNSHTEYN, MICHAEL

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<p align="center"><b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b></p>	<p><b>Application No.</b> 10/660,186</p>	<p><b>Applicant(s)</b> BECKLEY ET AL.</p>	
	<p><b>Examiner</b> MICHAEL M. BERNSHTEYN</p>	<p><b>Art Unit</b> 1796</p>	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 16 July 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 2 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-6, 11-13, 15, 16 and 18-26.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/David Wu/  
Supervisory Patent Examiner, Art Unit 1796

/Michael M. Bernshteyn/  
Examiner, Art Unit 1796

Continuation of 11: It appears that the focal Applicants argument resides in the contention that Straw does not teach or suggest that any curable composition (i.e., a composition that contains both Michael acceptor and Michael donor) may be prepared with less than 5% non-reactive volatile compounds. Straw refers to his curable composition as "water borne" (see the title, abstract, and paragraph #13), which means that his curable composition has more than 5% water (page 7). Therefore Applicants maintain that when Straw teaches removal of solvent from a mixture during the preparation of one ingredient, Straw is not teaching that his curable composition is solvent-free (page 8, 1<sup>st</sup> paragraph). In sum, Applicants submit that neither Straw nor Irie teach curable compositions with 5% or less non-reactive volatile compounds. Therefore Applicants submit that the Examiner has not presented a proper prima facie case for obviousness of present claim 1 over Irie in view of Straw.

It is noted that the first reference of Irie (U.S. Patent 5,959,028) exemplifies that the curable mixture comprises 5% or less by weight non-reactive volatile compounds (Example 31). The second reference of Straw (U. S. Patent Application Publication 2003/0165701) is used ONLY for recitation of common knowledge that coating composition curable by Michael reaction have several advantages. Liquid polymers and oligomers can be cross-linked to form tough hard coatings, so that the coating composition need have little or no volatile organic solvent to achieve a viscosity suitable for spray application (page 1, [0003]), and it is not important that the Straw composition itself is water-born. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made employ little or no volatile compounds as taught by Straw in Irie's resin composition curable through a Michael reaction in order to achieve a viscosity suitable for spray application (US'701, page 1, [0003], page 4, [0039]), and thus to arrive at the subject matter of instant claim 1 and dependent claims 22-24.

In response to Applicants arguments that it would not be obvious to combine the teachings of Leake with those of Irie. As set forth in detail in Applicants' previous papers, Leake teaches the use of certain specific highly reactive Michael donors and/or certain specific highly reactive Michael acceptors (page 9, 1<sup>st</sup> paragraph), it is noted that as it was already mentioned in the Office Action dated May 21, 2009, All these references are analogous art because they are from the same field of endeavor concerning new coating resin composition curing by Michael addition reaction. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the curing without the need for powerful catalysts as taught by Leake in combined Irie's and Straw's curable resin composition for coating in order to obtain Michael curing coating which cure more rapidly, particularly at ambient temperature (US'716, col. 2, lines 5-8), and thus to arrive at the subject matter of instant claim 25.

In response to Applicants arguments regarding claim 26 (page 9, the last paragraph), it should be repeated again that With regard to the limitations of claim 26, Irie discloses curable resin composition comprising: (a) a component containing a plurality of a,13-ethylenically unsaturated carbonyl groups in the molecule; b) an acrylate polymer containing a plurality of malonate-terminated pendant groups in the molecule; and (c) a catalyst capable of promoting the Michael reaction (col. 2, lines 10-15). Component (b) may be produced by copolymerizing a malonate-terminated acrylate monomer with a copolymerizable acrylic and/or non-acrylic monomer as exemplified in connection with component (a) (col. 3, lines 44-47). The malonate- terminated acrylate monomers have the formula, which is substantially identical to formulas in claim 12 (col. 3, lines 52-57). Therefore, component (b) corresponds to the claimed multi-functional Michael donor and accordingly to the claimed anion of Michael donor.